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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/710,309 | 07/01/2004 | David S. Bonalle | 70655.1500 | 4308 |
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| 20322 | 7590 | 11/21/2005 |
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SNELL & WILMER
ONE ARIZONA CENTER
400 EAST VAN BUREN
PHOENIX, AZ 850040001

EXAMINER

WALSH, DANIEL I

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 11/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/710,309 | BONALLE ET AL. | |
| | Examiner | Art Unit | |
| | Daniel I. Walsh | 2876 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of the Amendment received on 29 August 2005.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 11 recites the limitation "said data packet" in line 1. There is insufficient antecedent basis for this limitation in the claim. The Examiner is unclear of what makes up the data packet. For purposes of examination, the Examiner has interpreted the data packet to include the biometric sample and related information (account).

Appropriate correction/clarification is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor

and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black, as cited in the previous Office Action, in view of de Sylva (US 2005/0098621).

Re claim 1, Black teaches detecting a proffered biometric at a sensor communicating with the system to obtain a proffered biometric sample; verifying the proffered biometric sample and authorizing a transaction upon verification of the proffered biometric sample (FIG. 1C and abstract).

Black is silent to the sample being associated with at least two accounts where each accounts includes at least one of a charge account, credit card account, debit card account, savings accounts, private label account and loyalty point account, facilitating selection of an account.

The Examiner notes that it is well known and conventional that one card/transponder can have many consolidated accounts on it/access to many accounts, for convenience of the user (a consolidated card requires less cards to be carried by a user and is more convenient). Along those lines, de Sylva teaches that one sample is associated with at least two accounts through user account list 30, where only one biometric is required but a user sets an account list/priority.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black with those of de Sylva.

One would have been motivated to do this to have security (biometric) but have convenience as to set the account list/priority to select accounts based on users preferences,

which is more convenient than having to coordinate separate samples for separate accounts. The Examiner notes that as the user sets the account relationship, selection of accounts is facilitated, and a transaction is only authorized upon selection of the account (if a corresponding account exists) and verification of the sample.

Re claim 2, Black teaches the step of detecting included detecting a proffered biometric at a sensor configured to communicate with the system via at least one of a smartcard, reader, and network (FIG. 1C).

Re claim 3, Black teaches the step of detecting includes at least one of detecting, storing, and processing a proffered biometric sample (FIG. 1C and abstract).

Re claim 4, FIG. 1C shows a finite number of biometric samples are detected (fingerprint, signature).

Re claim 5, in Black teaches storing of digital and electronic signatures for record keeping purposes (paragraph [0125]). Additionally, the Examiner notes that biometric samples are stored/logged at least temporarily in other embodiments, just to compare/verify. The Examiner also notes McCall et al. (US 2003/0132297) which store/log signatures, Haala et al. (US 2005/0102524) which teaches recording details if authentication fails, and Segal et al. (US 2002/0066784) which teaches that a signature is bundled with transaction data and stored in a database to effect proof of a transaction.

Re claim 6, de Sylva teaches detecting a second proffered sample (paragraph [0037]+), for increased security. Additionally, Black teaches the step of detecting includes at least one of detecting, processing, and storing at least one second proffered biometric sample (FIG. 1C), which teaches both a signature and fingerprint.

Re claim 7, FIG. 1C teaches comparing a proffered biometric to a stored biometric.

Re claim 8, the Examiner notes that the proffered biometric is indeed compared with a sample of at least one of a criminal, a terrorist, and a card member (which should be the current card member) to authorize the transaction.

Re claim 9, Black teaches an embodiment where a transponder has information (fingerprint) stored on the device itself, and another embodiment where the signature is stored remotely (paragraph [0090]+) for security reasons. Accordingly, it is obvious that such data storage can be applied to a smartcard, as Black has already taught that the invention can relate to smartcard, transponders, etc. Therefore, it is obvious that the biometric sample would be verified using information contained remotely, such as in the instance when the signature is stored remotely (at customers bank). Though silent to the use of a database, the examiner notes that the use of a database as an obvious expedient for storing and accessing data on a computer device has been discussed above, and is obvious in order to have a means to access and retrieve data, well known in the art.

Re claim 10, as the reference data/signature is stored on the wireless card/transponder/device itself, it is obvious that the card reader processor verifies the sample, and is interpreted as one of a local CPU and third party security vendor.

Re claim 11, Black teaches that a unique identifier/customer number is associated with the user (FIG. 10A+). This is broadly interpreted as a personal identification number, or a unique means to verify a user/device. Additionally, the Examiner notes PIN-biometric combinations are well known and conventional in the art for increased security in systems. Therefore, using a PIN in addition to a biometric is an obvious expedient to increase security.

The Examiner also notes that de Sylva teaches that prior art systems use biometric and PINs for access (paragraph [0013]).

Re claim 12, Black teaches a fingerprint scan, for example (FIG. 1A).

Re claim 13, de Sylva teaches that certain amount purchases would be charged to certain accounts (paragraph [0047]). Therefore, it would have been obvious to one of ordinary skill in the art to set limits on accounts in accordance with their charging preferences, for example.

Re claim 14, the accounts of de Sylva are unassociated.

Response to Arguments

4. Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection. The Examiner has cited the new art of de Sylva in this Final Office Action (see above).

Additional Remarks

5. The Examiner notes that PINs associated with biometrics are well-known and conventional for increased security (versus just a biometric; see US 2001/0029493, 5,764,789, 2004/0084524, 2002/0174067, 2002/0062284, 2001/0018660 for example, which show that a PIN and biometric can be used for additional security over just a PIN or biometric, for example.) The Examiner also notes Royer et al. (US 2004/0155101) teaches the use of different biometrics

with multiple accounts and Ramachandran (US 2001/0013551) and Pitroda (US 6,925,439) which teach consolidation of card accounts onto one card for convenience.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

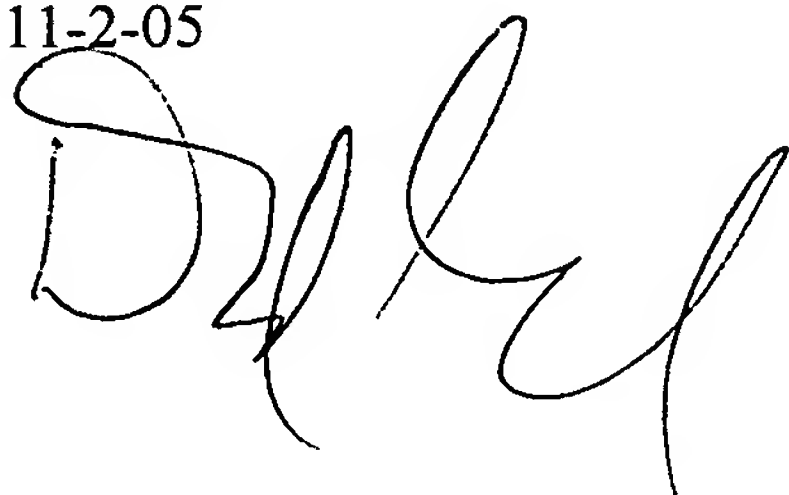
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel I Walsh
Examiner
Art Unit 2876
11-2-05



KARL D. FRECH
PRIMARY EXAMINER